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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	88190652
Applicant	BFY LLC
Applied for Mark	SLEEPEEZ
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Submission	Applicant's brief
Attachments	2021-06-04 SLEEPEEZ Appeal Brief - Final.pdf(452227 bytes)
Appealed class	Class 005. First Use: 0 First Use In Commerce: 0 All goods and services in the class are appealed, namely: Homeopathic pharmaceuticals for use in the treatment of children's sleeping problems; Medicated candies for use in the treatment of children's sleeping problems
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Date	06/04/2021

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial No. 88/190,652

Applicant: BFY, LLC

Mark:

SLEEPEEZ

Examining Atty: Erin Z. Dyer
Law Office 103

APPLICANT'S *EX PARTE* APPEAL BRIEF

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Applicant, BFY, LLC, respectfully appeals the Examining Attorney's refusal to register Applicant's mark, namely the standard character SLEEPEEZ mark in Application Serial No. 88/190,652 ("Applicant's Mark"). The Examining Attorney made a final refusal on the grounds that Applicant's Mark, for use in connection with "[h]omeopathic pharmaceuticals for use in the treatment of children's sleeping problems" and "[m]edicated candies for use in the treatment of children's sleeping problems" in International Class 5, is confusingly similar to the mark SLEEPEASE (Reg. No. 4,123,390) pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d). In refusing registration, the Examining Attorney rejected Applicant's position, namely that the registered mark is weak due to widespread use of similar marks for similar goods, and thus the differences in the marks are enough to negate any likelihood of confusion.

PROSECUTION HISTORY

Applicant's standard character mark application was filed on November 12, 2018, seeking registration on the Principal Register for the mark SLEEPEEZ for intent to use in connection with "[h]omeopathic pharmaceuticals for use in the treatment of sleeping problems; [m]edicated candies" in International Class 5.

On December 10, 2018, the Examining Attorney issued an Office Action, refusing to grant registration on the Principal Register under Section 2(d), 15 U.S.C. § 1052(d), finding that Applicant's mark confusingly similar to the mark SLEEPEASE (Reg. No. 4,123,390), registered in connection with "[h]omeopathic preparations in the nature of an oral spray for the treatment of insomnia and symptoms of insomnia such as wakefulness, restlessness, caffeine sensitivity, emotional stress and anxiety" in International Class 5. The Examining Attorney also noted a prior-filed application for the mark DR. CLIFF'S SLEEPEEZ (Ser. No. 88/176,785), applied for

in connection with dietary supplements in International Class 5, that had the potential to cause confusion with Applicant's mark should it become registered. Finally, the Examining Attorney also required that Applicant clarify its identification of goods to more accurately describe its products and their intended use.

On June 10, 2019, Applicant filed an Office Action response, arguing against the Section 2(d) refusal and amending the identification of goods in Class 5 to "[h]omeopathic pharmaceuticals for use in the treatment of children's sleeping problems; Medicated candies for use in the treatment of children's sleeping problems."

On July 1, 2019, the Examining Attorney suspended the application pending the outcome of Application Ser. No. 88/176,785 for the DR. CLIFF'S SLEEPEEEZ mark. In the same action, the Examining Attorney accepted the new identification of goods, yet maintained the refusal based on likelihood of confusion.

On September 10, 2020, Applicant's application was removed from suspension after Application Ser. No. 88/176,785 for DR. CLIFF'S SLEEPEEEZ was abandoned. In the notice removing the application from suspension, the Section 2(d) refusal based on SLEEPEASE (Reg. No. 4123390) was made final.

On March 10, 2021, Applicant filed a Request for Reconsideration and a Notice of Appeal to the Board. In its Request for Reconsideration, Applicant incorporated additional evidence to demonstrate that the combination of "SLEEP" and "EASE" is relatively conceptually and commercially weak in the market for sleep aids, which would allow consumers to differentiate between the marks based on their different spellings. Applicant also emphasized its ownership of U.S. trademark Registration No. 6,086,186 for the mark TUMEEZ in standard characters for use in connection with "[m]edicated candies" in International Class 5, Registration

No. 5,413,866 for the mark LOLLEEZ in standard characters for use in connection with “medicated hard candies for sore throat and cough relief” in International Class 5, and claimed its ownership of Registration No. 6,190,257 for the mark MOMEEZ CHOICE in standard characters for use in connection with “[h]omeopathic pharmaceuticals for use in the treatment of children's ailments, namely, sore and irritated throats, constipation, stomach gas, gastric and stomach ills, seasonal allergies, temperament; Medicated candies” in International Class 5. Finally, Applicant provided evidence that its family of “-EEZ” marks is well-known, including articles from highly circulated publications in which Applicant’s family of marks were featured, as well as sales figures.

On April 6, 2021, the Examining Attorney denied the Request for Reconsideration.

On April 7, 2021, the Board resumed the proceeding and allowed Applicant sixty days to file its Appeal Brief.

SUMMARY OF EVIDENCE

Examining Attorney’s Evidence

1. Office Action of December 10, 2018

- Registration certificate for Reg. No. 77587309;
- Copy of application for Application Ser. No. 88176785;
- *Ease*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/ease> (last visited Dec. 10, 2018);
- *Ease*, THE AMERICAN HERITAGE DICTIONARY, <https://www.ahdictionary.com/word/search.html?g=ease>;
- *Sleep and Relaxation*, PURITAN’S PRIDE, <https://www.puritan.com/sleep-relaxation-1856?filter=Brand%7C64f5ffff-6f5a-4b5a-b65f-5e08dda443b3> (last visited Dec. 10, 2018);
- *Peaceful Sleep Oil Blend*, NOW FOODS, <https://www.nowfoods.com/essential-oil/peaceful-sleep-oil-blend> (last visited Dec. 10, 2018);
- *Sleep Veg Capsules*, NOW FOODS, <https://www.nowfoods.com/upplements/sleep-veg-capsules> (last visited Dec. 10, 2018);
- *Sleep-Pain*, TYLENOL, <https://www.tylenol.com/prodcuts/sleep-pain> (last visited Dec. 10, 2018);
- Registration certificate for Reg. No. 4909433;
- Registration certificate for Reg. No. 5042663;
- Registration certificate for Reg. No. 5138848;

- Registration certificate for Reg. No. 5556425;
- Registration certificate for Reg. No. 5576540.

2. Suspension Letter of July 1, 2019

- “Allergeez defined,” GOOGLE search (executed June 29, 2019);
- “Allergeez defined,” BING search (executed June 29, 2019);
- “*iz*” or “*ez*” pronunciation of a plural noun, WORD REFERENCE, <http://forum.wordreference.com/threads/iz-or-ez-pronunciation-of-a-plural-noun-2318991> (last visited June 29, 2019);
- Pronunciation of “-ies” in plural forms such as “policies,” Word Reference, <https://forum.wordreference.com/threads/pronunciation-of-ies-in-plural-forms-such-as-policies-2993785> (last visited June 29, 2019).

3. Final Office Action of September 10, 2020

- *Ease*, LEXICO, <https://www.lexico.com/en/definition/ease> (last visited Sept. 10, 2020);
- *Ease*, INFOPLEASE, <https://www.infoplease.com/dictionary/ease> (last visited Sept. 10, 2020);
- *Ease*, DICTIONARY.COM, <https://www.dictionary.com/browse/ease> (last visited Sept. 10, 2020);
- *Sleep Support*, NATROL, <https://www.natrol.com/store/sleep-support> (last visited Sept. 10, 2020);
- *Vicks Pure Zzzs*, WALMART, <https://www.walmart.com/ip/Vicks-Pure-Zzzs-Kids-Melatonin-Liquid-Sleep-Aid...> (last visited Sept. 10, 2020);
- *Immunity Zzzs Gummies*, VICKS, <https://vicks.com/en-us/shop-products/vicks/immunity-zzzs-gummies> (last visited Sept. 10, 2020);
- *Insomnia*, HYLAND’S, <https://www.hylands.com/products/hylands-insomnia> (last visited Sept. 10, 2020);
- *Kids Sleep*, HYLAND’S, <https://www.hylands.com/products/kids/sleep> (last visited Sept. 10, 2020).
- *Products*, ZARBEES, <https://www.zarbees.com/products> (last visited Sept. 10, 2020);
- *Home*, NESTED NATURALS, <https://nestednaturals.com> (last visited Sept. 10, 2020);
- Registration certificate for Reg. No. 5541301;
- Registration certificate for Reg. No. 4907554;
- Registration certificate for Reg. No. 5131147;
- Registration certificate for Reg. No. 5396938;
- Registration certificate for Reg. No. 5419182;
- Registration certificate for Reg. No. 5378189;

- Registration certificate for Reg. No. 5730754;
- Registration certificate for Reg. No. 5512563;
- Registration certificate for Reg. No. 5895379;
- Registration certificate for Reg. No. 5969324.

Applicant's Evidence

1. Office Action Response of April 15, 2020

- **Exhibit A:** *Our Story*, MOMEEZ CHOICE, <https://momeezchoice.com/our-story> (last visited June 7, 2019);
- **Exhibit B:** *Home*, MOMEEZ CHOICE, <https://momeezchoice.com/> (last visited June 7, 2019);
- **Exhibit C:** *Lolleez*, MOMEEZ CHOICE, <https://momeezchoice.com/lolleez> (last visited June 7, 2019);
- **Exhibit D:** *Lolleez*, Registration No. 5,413,866;
- **Exhibit E:** *Tumeez*, MOMEEZ CHOICE, <https://momeezchoice.com/tumeez> (last visited June 7, 2019);
- **Exhibit F:** *Edens Garden Sleep Ease 10 ml Synergy Blend 100% Pure Undiluted Therapeutic Grade GC/MS Certified Essential Oil*, AMAZON, <https://www.amazon.com/Edens-Garden-Undiluted-Therapeutic-Certified/dp/B018835HXX?th=1> (last visited June 7, 2019);
- **Exhibit G:** *Premium Sleep Ease Formula*, ATMA NUTRITION, <https://www.atmanutrition.com/products/sleep-ease-natural-sleep-aid-promotes-relaxation-non-habit-forming-sleeping-pills-with-5-htp-melatonin-gaba-and-more-non-gmo-for-men-women> (last visited June 7, 2019);
- **Exhibit H:** *Sleep Ease*, HERBIARY, <https://herbiary.com/sleep-ease/> (last visited June 7, 2019);
- **Exhibit I:** *Sleep-ease*, ECONOMY PHARMACY, <https://economypharmacy.com/product/sleep-ease/> (last visited June 7, 2019);
- **Exhibit J:** *Sleep ease oil*, MOUNTAIN ROSE HERBS, <https://www.mountainroseherbs.com/products/sleep-ease-oil/profile> (last visited June 7, 2019);
- **Exhibit K:** *Sleep-Ease CR Melatonin*, WOODSTOCK VITAMINS, <https://www.woodstockvitamins.com/products/sleep-ease-cr-90-tablets> (last visited June 7, 2019);
- **Exhibit L:** *Sleep Ease Inhalation Beads*, HEALTHJOURNEYS, <https://www.healthjourneys.com/sleep-ease-inhalation-beads> (last visited June 7, 2019);
- **Exhibit M:** *AromaRemedy Sleep Ease Bag*, AMAZON, https://villageherbshop.com/moreinfo/AromaRemedy_Sleep_Ease_Bag (last visited June 10, 2019);
- **Exhibit N:** Third-Party Registration Certificates for Registration Nos. 4,354,543; 4,944,530; 1,861,728; 4,779,942; 1,921,390; and 5,237,758.

2. Request for Reconsideration of March 10, 2021

- **Exhibit O:** *Professional Botanicals Sleep Eaze*, NHC, https://www.nhc.com/sleep-eaze-by-professional-botanicals?quantity=1&gclid=Cj0KCQiA1pyCBhCtARIsAHaY_5fWQSfzsthSXU2ZeNni2MVfR6RWeeP1ttfqF3ILaGzTyu0GnYBZuIIaApQ3EALw_wcB (last visited Mar. 9, 2021);
- **Exhibit P:** *Sleep.eze Extra Strength, 20 GelCaps*, OLIVE TIPS, https://www.olivetips.com/products/sleep-eze-extra-strength-20-gelcaps?gclid=Cj0KCQiA1pyCBhCtARIsAHaY_5cra1d1m2qRGUC2PmCUpSR-1TNm0bSLsUA0abPbrWkiSvM_xVb8PeAaAkYgEALw_wcB (last visited Mar. 9, 2021);
- **Exhibit Q:** *Sleep Ez (Sleep Ease), 60 Vege Capsules, 800 Mg Each (Concentrated)*, AMAZON, <https://www.amazon.com/Sleep-Ease-Vege-Capsules-Concentrated/dp/B01N0WU0BC> (last visited Mar. 9, 2021);
- **Exhibit R:** *Herbs of Gold Sleep Ease 30 capsules*, LIVE LIFE PHARMACY, <https://livelifepharmacy.com/shop/herbs-of-gold-sleep-ease-30-capsules/> (last visited Mar. 9, 2021);
- **Exhibit S:** *SleepEase*, ILLUMINUTRI, <http://illumnutri.com/store/products/SleepEase.html> (last visited Mar. 9, 2021);
- **Exhibit T:** *FULL SPECTRUM CURCUMIN SLEEP EASE LICAPSTTM*, SOLGAR, <https://www.solgar.com/products/full-spectrum-curcumin-sleep-ease-licaps/> (last visited Mar. 9, 2021);
- **Exhibit U:** *Sleep Ease Dream Mineral Salts*, AROMAFLORIA, <https://aromafloria.com/products/sleep-ease-dream-mineral-salts> (last visited Mar. 9, 2021);
- **Exhibit V:** *Balance SleepEz*, MOR'S NUTRITION & MORE! <https://www.mor-nutrition4life.com/product/balance-sleepez/> (last visited Mar. 9, 2021);
- **Exhibit W:** *SleepEZ Tincture*, VITADREAMZ, <https://vitadreamz.com/collections/all/products/sleepez-tincture> (last visited Mar. 9, 2021);
- **Exhibit X:** *Sleep EZE Herbal Sleep Aid - 60 Capsules*, AMAZON, <https://www.amazon.com/Sleep-EZE-Herbal-Aid-Capsules/dp/B01DZ5VTO2> (last visited Mar. 9, 2021);
- **Exhibit Y:** *SleepEase Synergy*, NATURE'S GIFT, <https://naturesgift.com/product/sleepease-synergy/> (last visited Mar. 9, 2021);
- **Exhibit Z:** *Diffuser Blend, Sleep Ease*, DROPWISE ESSENTIALS, <https://www.dropwise.com/diffuser-blend-sleep-ease/> (last visited Mar. 9, 2021);
- **Exhibit AA:** *Sleep Ease Essential Oil*, STACKSOCIAL, <https://stacksocial.com/sales/sleep-ease-essential-oil> (last visited Mar. 9, 2021);
- **Exhibit AB:** *Sleep Ease Dream Mood Mist*, AROMAFLORIA, <https://aromafloria.com/products/sleep-ease-dream-mood-mist> (last visited Mar. 9, 2021);

- 9, 2021);
- **Exhibit AC:** *Sirius Sleep Ease*, SIRIUS IN VERMONT, <https://siriusinvermont.com/essential-oils/16-sirius-sleep-ease.html> (last visited Mar. 9, 2021);
 - **Exhibit AD:** *Massu Aromatherapy Massage Candle Sleep Ease 75g*, AMAZON, <https://www.amazon.co.uk/Massu-Aromatherapy-Massage-Candle-Sleep/dp/B0046A44MA> (last visited Mar. 9, 2021);
 - **Exhibit AE:** *Sleep Ease*, LEAF LOGIC, <https://leaflogictea.com/shop-tea/sleep-ease> (last visited Mar. 9, 2021);
 - **Exhibit AF:** *Sleep EZ - Liquid Melatonin with B6 and Theanine - Natural Sleep Aid - Helps You Rest Peacefully, Wake Up Energized*, Amazon, <https://www.amazon.com/Natural-Nutritional-Solutions-Sleep-Ez/dp/B01I0CEIY8> (last visited Mar. 9, 2021);
 - **Exhibit AG:** *Ease*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/ease> (last visited Mar. 9, 2021);
 - **Exhibit AH:** Registration certificates for Reg. Nos. 4854380 and 3827575;
 - **Exhibit AI:** *Our Story*, MOMEEZ CHOICE, <https://momeezchoice.com/our-story/> (last visited Oct. 22, 2020);
 - **Exhibit AJ:** Registration certificate for Reg. No. 6190257;
 - **Exhibit AK:** Sales and Recognition Information for Applicant's "-EEZ" Marks;
 - **Exhibit AL:** *Organic Throat Soothing Kids Pops Watermelon, Strawberry, Orange, Mango*, WALGREENS, <https://www.walgreens.com/store/c/lolleez-organic-throat-soothing-kids-pops-watermelon,-strawberry,-orange-mango/ID=300395321-product> (last visited Oct. 22, 2020);
 - **Exhibit AM:** *Tumeez Organic Tummy Soothing Pops, Variety Pack, Grape/Apple*, RITE AID, <https://www.riteaid.com/shop/tumeez-organic-tummy-soothing-pops-variety-pack-grape-apple-10-ct> (last visited Oct. 22, 2020);
 - **Exhibit AN:** *Lolleez Immunitiez Organic Immune Support Pops for Kids – Elderberry – 10ct*, TARGET, https://www.target.com/p/lolleez-immunitiez-organic-immune-support-pops-for-kids-elderberry-10ct/-/A-79833287?ref=tgt_adv_XS000000&AFID=google_pla_df&fndsrc=tgtao&DFA=71700000049427611&CPNG=PLA_Health+Shopping_Local&adgroup=SC_Health&LID=700000001170770pgs&LNM=PRODUCT_GROUP&network=g&device=c&location=9008162&targetid=pla-553221420469&ds_rl=1246978&ds_rl=1248099&gclid=Cj0KCQjw28T8BRDbARIsAEOMBcw8ZTnDSstRSwczQBisW64HXh06cvyQVOTVctX2uyGseGVgU6SW5s4aAs1TEALw_wcB&gclsrc=aw.ds (last visited Oct. 22, 2020);
 - **Exhibit AO:** @momeezchoice, INSTAGRAM, <https://www.instagram.com/momeezchoice/?hl=en> (last visited Mar. 9, 2021);
 - **Exhibit AP:** Star Staff, "Keeping Kids Happy and Healthy, One Lolli at a Time,"

Star (Oct. 16, 2020), <https://starmagazine.com/videos/keeping-kids-happy-and-healthy-one-lolli-at-a-time/> (last visited Oct. 22, 2020);

- **Exhibit AQ:** In Touch Staff, “Keeping Kids Happy and Healthy, One Lolli at a Time,” In Touch (Oct. 16, 2020), <https://www.intouchweekly.com/posts/keeping-kids-happy-and-healthy-one-lolli-at-a-time/> (last visited Oct. 22, 2020);
- **Exhibit AR:** *Press*, Momeez Choice, <https://momeezchoice.com/press/> (last visited Oct. 26, 2020);
- **Exhibit AS:** *Kids Love Lolleez Pops*, LITCHFIELD MAGAZINE, <http://happeninginthehills.com/onourradar/kids-love-lolleez-pops/> (last visited Oct. 26, 2020);
- **Exhibit AT:** Sara Ahmed, “Why I Never Give My Kids Medicine, Only Natural Remedies,” POPSUGAR (Oct. 22, 2018), <https://www.popsugar.com/family/Natural-Health-Remedies-Kids-44519758> (last visited Oct. 26, 2020);
- **Exhibit AU:** Team Scary Mommy, “Being Sick Sucks, But These Lollipops Are Magic For Little Sore Throats,” SCARY MOMMY (Dec. 10, 2018, updated May 5, 2020), <https://www.scarymommy.com/sore-throat-soothing-lollipops/> (last visited Oct. 26, 2020).

ARGUMENT

The Examining Attorney has refused registration of Applicant’s mark pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on grounds that Applicant’s SLEEPEEZ standard character mark for “[h]omeopathic pharmaceuticals for use in the treatment of children’s sleeping problems” and “[m]edicated candies for use in the treatment of children’s sleeping problems” in International Class 5 is likely to cause confusion with the mark SLEEPEASE registered in connection with “[h]omeopathic preparations in the nature of an oral spray for the treatment of insomnia and symptoms of insomnia such as wakefulness, restlessness, caffeine sensitivity, emotional stress and anxiety” in International Class 5. Because there are many marks registered on the Principal Register and in use in commerce that use “SLEEP” and “EASE” in connection with sleep aid products, it is likely that consumers would be able to differentiate between the marks based on their different spellings and product offerings.

I. The Registered Mark is Relatively Weak, and Therefore the Differences Are Enough to Differentiate the Marks.

Widespread third-party use of the combination of the words “SLEEP” and “EASE/EZ/EZE/EAZE” for sleeping aids has weakened the trademark significance of the terms and the scope of protection afforded to the cited mark. “Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.” *Sure-fit Products Company v. Saltzson Drapery Company*, 254 F.2d 158, 160 (CCPA 1958).

Third-party registration evidence *and* third-party use evidence have been repeatedly found relevant to determine the strength of a mark, and therefore the scope of its protection. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (finding that internet evidence of 15 third-party marks in use as well as 17 registered marks was sufficient to show that a paw print mark was relatively weak within the clothing industry); *Juice Generation, Inc. v. GS Enters. LLC*, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (finding at least twenty-six relevant third-party uses or registrations of record enough to establish that the phrase “PEACE AND LOVE” was relatively weak within the food industry). Once it has been established that a mark is weak, even minute differences can be enough to negate any potential likelihood of confusion. *See Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d (BNA) 1030, 1036 (TTAB 2016) (holding that expert testimony alongside third-party websites and registrations were enough to demonstrate that customers are exposed to “so many different ROSE and ROSE-formative marks and names in connection with senior living communities that they likely have become alert to “minute distinctions” among the various marks); *see also Anthony's Pizza & Pasta Int'l, Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d (BNA) 1271, 1278 (TTAB 2009) (finding that, due to evidence

of at least 29 other marks in use and 15 registrations using the name “ANTHONY’S” for similar services, ANTHONY’S PIZZA & PASTA was “not entitled to such a broad scope of protection that it is a bar to the registration of every mark comprising, in whole or in part, the name “Anthony’s”; it will only bar the registration of marks ‘as to which the resemblance to [plaintiff’s mark] is striking enough to cause one seeing it to assume that there is some connection, association or sponsorship between the two.’” (internal citations omitted)).

Here, because there are at least 26 other marks for sleep aid products being used in commerce that are phonetically (and often visually) identical to the registered SLEEPEASE mark and there are at least eight third-party registrations on the Principal Register that contain “SLEEP” and “EASE” for similar products, Registrant’s SLEEPEASE mark is entitled to a narrow scope of protection, such that the differences in spelling and products will be enough to alleviate consumer confusion.¹

A. There is Extensive Third-Party Use of “SLEEP” and “EASE”

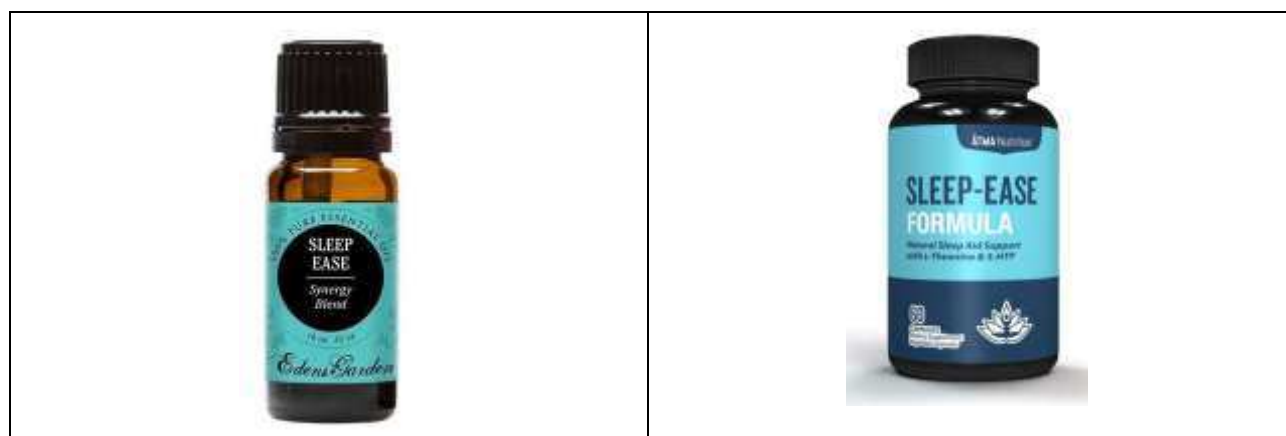
Here, the record demonstrates that third parties regularly use a combination of the words “SLEEP” and “EASE” in commerce. Evidence establishing that the consuming public is exposed to third-party use of similar marks on similar goods “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). In *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, the Federal Circuit noted that, “extensive evidence of third party use and registration is ‘powerful on its face’ even where the specific extent and impact of the usage has not been established.” 116 USPQ2d 1129, 1136 (Fed. Cir. 2015).

¹ Applicant also notes that its “-EEZ” suffix may be interpreted as the word “EASE,” but also may be a phonetic equivalent of the suffix “-IES,” making its mark “SLEEPIES.” Applicant does not concede that its mark necessarily will be interpreted as “SLEEPEASE” by consumers.

Evidence of third-party use of similar marks for similar goods demonstrates that a mark is relatively weak because it necessarily means that consumers have been exposed to a plethora of such marks and are therefore “educated to distinguish” among them. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005); *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 USPQ 383, 385 (TTAB 1976); *see also In re FiftyThree, Inc.*, 2017 TTAB LEXIS 132 (TTAB 2017) (third-party uses of PAPER for digital notebooks showed that the word had been extensively adopted as a trademark for such goods; giving the cited mark BAMBOO PAPER a “restricted scope of protection” and reversing refusal to register PAPER); *In re Broadway Chicken, Inc.*, 38 USPQ2d (BNA) 1559, 1564-1565 (TTAB 1996) (holding that telephone directory and business database evidence showing BROADWAY marks in use for restaurant services was enough to determine BROADWAY was weak and entitle it only to a narrow scope of protection).

In its first Office Action response, Applicant produced eight use-based third-party marks. *See* table below and Applicant’s Office Action response of June 10, 2019, Exhibits F-M.

Table 1 - Third-Party Marks Using “SLEEP” and “EASE” for Sleep Aid Goods





In its Request for Reconsideration, Applicant provided evidence of an additional **18** third-party marks being used in commerce. *See* Table 2, below, and Applicant's Request for Reconsideration, Exhibits O-AF.

Table 2 – Third-Party Marks Using “SLEEP” and “EASE” for Sleep Aid Goods

 <p>A small white plastic bottle with a blue label. The label features the brand name 'Botanix' at the top, followed by 'Sleep Eze' in large white letters on a blue background. There is a small green leaf icon on the right side of the label.</p>	 <p>A purple and white box for 'Sleep-eze' gelcaps. The box has 'Sleep-eze' in a stylized white font on a purple background. Below it, it says 'gelcaps' and 'EXTRA STRENGTH'. There is a small illustration of a person sleeping.</p>
 <p>A white plastic bottle with a green label. The label has 'Sleep Ez' in a large, stylized green font. Below it, it says 'Herbal Supplement' and '30 Capsules'. At the bottom, there is a small instruction: 'Roll over bridge to open it'.</p>	 <p>A brown glass bottle with a gold and blue label. The label features the brand 'herbs of gold' at the top, followed by 'Sleep Ease' in large white letters. Below it, it says 'Herbal Supplement' and '30 Capsules'. There is a small illustration of a person sleeping.</p>
 <p>A white plastic bottle with a yellow and green label. The label features the brand 'BILAMINUTRO' at the top, followed by 'Sleep Eze' in large white letters. Below it, it says 'Herbal Supplement' and '30 Capsules'.</p>	 <p>A white box for 'Curcumin Sleep Ease'. The box has 'Curcumin' in large black letters and 'Sleep Ease' in a stylized blue font. Below it, it says 'Herbal Supplement' and '30 Capsules'. There is a small illustration of a person sleeping.</p>
 <p>A white plastic bottle with a blue label. The label features the brand 'MOMATECH' at the top, followed by 'Sleep Eze' in large white letters. Below it, it says 'Herbal Supplement' and '30 Capsules'.</p>	 <p>A white plastic bottle with a yellow and orange label. The label features the word 'FOOD' in large white letters on a yellow background. Below it, it says 'Balance SleepEZ' in large white letters. There is a small illustration of a person sleeping.</p>




All of the above marks are used in connection with inhalable or ingestible substances that are meant to aid in going to sleep, staying asleep, or having more restful sleep. For example, like

the registered SLEEPEASE mark, the marks  (SLEEP EASE SYNERGY),

 (SLEEP EASE),  (SLEEP EASE),  (SLEEP EASE), and  (SIRIUS

SLEEP EASE) are all used for inhalable or ingestible sprays. *See* Applicant's Request for Reconsideration, Exhibits Y-AC. It is also notable that all of the goods sold under these marks are offered over the internet, making their geographic scope anywhere within the United States.

For example,  (The SLEEP EASE SYNERGY BLEND essential oil),  (SLEEP EASE

aromatherapy bag),  (SLEEPEZE sleep capsules) are sold via Amazon. *See* Applicant's

Office Action response of June 10, 2019, Exhibits F, M, and X. Importantly, *all 26 marks in Tables 1 and 2* above, use the entirety of the registered SLEEPEASE mark.

As such, it is evident that consumers are exposed to a high number of “SLEEP” plus “EASE” marks for sleep aid goods and have learned to differentiate between them based on differences in spelling, goods, or other factors. Given that Applicant’s mark is spelled using the “-EEZ” suffix and is used on ingestible vitamins and candies (as opposed to the Registrant’s identified oral sprays), it is even more likely that consumers would recognize the differences and understand that Applicant’s and Registrant’s goods do not originate from the same source.

B. There is Extensive Third-Party Registration of “SLEEP” and “EASE”

The Registrant’s mark has diminished source identifying significance because the combination of “SLEEPEASE” is highly suggestive. “EASE” means “free from pain or discomfort.” *See* Applicant’s Request for Reconsideration, Exhibit AG. The combination of SLEEPEASE, then, implies the homeopathic oral spray product sold under the SLEEPEASE mark helps make going to sleep or staying asleep less difficult or without discomfort. This meaning is highly suggestive of a characteristic of the goods, and therefore Registrant’s mark is entitled to a narrower scope of protection, such that Applicant’s mark can coexist on the trademark register.

Registration evidence can also be used to support and corroborate the evidence of a term’s descriptiveness or suggestiveness overall. *See In re UST Global (Sing.) Pte. Ltd.*, 2020 USPQ2d (BNA) 10435, *8 (TTAB 2020) (holding that 23 registrations cited by the Examining Attorney, coupled with evidence of the definition, are enough to find “LABS” descriptive for think tank services). Third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used in ordinary parlance that the public will

look to other elements to distinguish the source of the goods. *See Juice Generation*, 115 USPQ2d at 1674-75; *see also Institut Nat'l des Appellations D'Origine v. Vinters Int'l Co. Inc.*, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (“[T]hird party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services.”) The Board has even previously held, in *In re Boston Juicery*, that 12 third-party registrations containing the word “SQUEEZE” in conjunction with fruit juices, smoothies, juice bar services, café services were enough, on their own, to prove that the word was highly suggestive and that the cited mark in that case was entitled to a narrow scope of protection for those goods. 2018 TTAB LEXIS 313, *11-14 (TTAB 2018). This all emphasizes that “even where the specific extent and impact of the usage has not been established,” registration evidence of third-party use is relevant to show that a term “may have a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that [term] is relatively weak,” and “can show that customers have been educated to distinguish between different marks on the basis of minute distinctions.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

In the Office Action response submitted on June 10, 2019, Applicant included details and certificates for six active third-party registrations containing the words “SLEEP” and “EASE.” Each of these third-party marks is registered in conjunction supplements or other sleep aids. *See* Table 3 below, and Applicant’s Office Action response of June 10, 2019, Exhibit N.

Table 3 - Third Party Registrations Using “SLEEP” and “EASE” for Sleep Aid Goods

Mark	Reg. No.	Goods
Easy2Sleep	4354543	Class 5: Dietary supplement beverages for aiding sleep
GO Sleep with Ezzz	4944530	Class 5: Dietary and nutritional supplements
SLEEP-EASY	1861728	Class 10: ear plugs for medical use or for use as a sleep aid
SLEEP EASY	4779942	Class 5: Dietary supplements for aiding sleep
SLEEP EASE	1921390	Class 3: non-medicated bath salts, bath gels and body lotions Class 5: medicated bath salts
E-Z SLEEP SLEEP SHOT	5237758	Class 5: Nutritional supplements for use as a sleep aid

In its Request for Reconsideration, Applicant added the two marks below that are registered on the Principal Register – SLEEP COMES EASY and SLEEP-EZ

AROMATHERAPY. *See* Table 3 and Applicant’s Request for Reconsideration, Exhibit AH.

Table 4 - Third Party Registrations Using “SLEEP” and “EASE” for Sleep Aid Goods

Mark	Reg. No.	Goods
SLEEP COMES EASY	4854380	Class 3: Bath salts; Body lotions; Body sprays; Non-medicated balms for use on skin; Non-medicated body soaks
SLEEP-EZ AROMATHERAPY	3827575	Class 3: Scented linen sprays; Scented room sprays

The registered marks SLEEP-EZ AROMATHERAPY, SLEEP EASY, SLEEP-EASY, and SLEEP EASE all feature the full word “SLEEPEASE” or a phonetic equivalent. Such registrations are probative to demonstrate that all of the wording in the cited Registration - “SLEEPEASE” - is commonly used in ordinary parlance to identify ingestible or inhalable sleep aids, making the term relatively weak. Thus, because Applicant’s marks contain the suffix “-

EEZ” to set itself apart visually from each of these third-party registrations, consumers are unlikely to be confused.

In sum, because consumers are likely to have been exposed to a large amount of similar marks for sleep aid goods in the market place, and it has been demonstrated that using the combination of “SLEEP” and “EASE” is highly suggestive of such products, it is likely that consumers would be able to differentiate among the products even based on small differences. In this case, they will be able to use the difference in suffix spelling (-EEZ vs. -EASE) and differences in goods (pharmaceuticals and medicated candies vs. oral sprays) to understand that the goods do not originate from the same source.

CONCLUSION

Based on the foregoing, consumers are unlikely to be confused as to the source of Applicant’s and Registrant’s goods. Applicant reiterates its arguments that although Applicant’s mark and Registrant’s marks feature the term “SLEEP,” consumers are likely able to differentiate between the marks based on their aesthetic differences, particularly as Applicant’s mark contains the unique suffix “-EEZ.” This is especially true where use of the words “SLEEP” and “EASE” are highly diluted in the field of ingestible sleep aids. Moreover, if Registrant believes that they will be harmed by the registration of Applicant’s mark, they may make their case during the opposition period.

WHEREFORE, Applicant respectfully requests that the Board REVERSE the statutory refusal pursuant to Trademark Act Section 2(d) and allow the Application to proceed to publication and registration on the Principal Register.

Dated this 4th day of June, 2021.

Respectfully submitted,

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